

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. HAWKINGS

Appeal No. 96-0043
Application 08/059,043¹

ON BRIEF

Before CALVERT, CAROFF and PAK, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1,
2,

¹ Application for patent filed May 7, 1993.

Appeal No. 96-0043
Application 08/059,043

5 to 10 and 12 to 14, all of the claims remaining in the application.

Claim 1 defines the subject matter in issue as:

1. A heat recoverable pre-formed article comprising:

a substantially hollow enlarged section for receiving a wire bundle to be sealed, said enlarged section having a slit therein;

a pair of tab portions disposed adjacent to each other and extending outwardly from said slit so as to be substantially aligned with each other;

wherein said tab portions are biased toward each other such that upon insertion of the wire bundle into said enlarged section, said tab portions are spread apart and return to their original adjacent, biased position upon snapping of the wire bundle into said enlarged section.

The references relied upon by the examiner in the final rejection are:

Kunze 1981	4,280,258	Jul. 28,
Peacock 1990	4,900,596	Feb. 13,
German patent (Sachsse) 1992 ²	4,032,376	Apr. 16,

² A translation of this reference, prepared for the Patent and Trademark Office, is enclosed herewith.

Appeal No. 96-0043
Application 08/059,043

Two additional references applied below in rejections pursuant to 37 CFR § 1.196(b) are:

Cook et al. (Cook) 1963	3,086,242	Apr. 23,
Ellis 1969	3,455,336	Jul. 15,

Claims 1, 2, 5-10 and 12-14 stand finally rejected under 35 U.S.C. § 103 as unpatentable over Peacock alone, or in view of Kunze or Sachsse.

Considering first the rejection of claim 1 as unpatentable over Peacock, the examiner finds that Peacock discloses (answer, pages 3 and 4):

a heat recoverable pre-formed article comprising a substantially hollow enlarged section for receiving a wire bundle, with this enlarged section having a slit therein. See Figures 1, 3, and 11. As shown in Figure 1, the article includes a pair of tab portions disposed adjacent each other and extending outwardly from the slit so as to be aligned with each other. The shape of the article inherently biases the tabs toward one another in the manner claimed, although the reference does not discuss this. The Peacock article is formed of a cross linked polymer which can have its interior surface coated with a hot melt or other suitable adhesive. At column 9, lines 47 to 49 the reference appears to teach that the slit open composite can have its edge structure formed into a variety of conventional shapes, such as are claimed here.

Appeal No. 96-0043
Application 08/059,043

Appellant's only argument with regard to this rejection is that the edges of the Peacock article are not biased toward each other, mechanical joining means being required to hold the edges together.

We agree with the examiner that the fact that Peacock discloses mechanical joining means (e.g., channel 3) does not mean that edges 2 of Peacock's sleeve are not "biased toward each other," as claimed, since the claim language "does not preclude the presence of a mechanical fastener" (answer, page 5). Also, we agree with the examiner that "the term bias[ed] means only that the edges or tabs tend toward each other" (id.), this interpretation being consistent with the definition of this term at page 2, lines 17 to 19 of the specification (emphasis added):

The term "biased" as used herein merely implies a tendency of the planar sections to return to their position adjacent to each other.

Our agreement with the examiner notwithstanding, however, we will not sustain the rejection of claim 1, for it does not appear that the edges 2 of the Peacock sleeve would be biased towards each other at all. The reason for this finding is the fact that Peacock's sleeve is not made from an article having

any kind of preformed tubular shape, but rather is made from a fabric. The fabric would have no tendency of its own to assume a circular shape (i.e., to bias the edges toward each other), but rather is a flexible, flat material which is wrapped around the pipe or cable and its free edges, containing closure members 5, are then secured together by a channel 3 or other means. The lack of bias is illustrated by Peacock's disclosure that the sleeves may be produced from the (flat) fabric as it comes off the loom (see Fig. 4 and column 15, lines 44 to 66).

The examiner refers to column 9, lines 47 to 49, as appearing to teach forming the edge structure of "the slit open composite" into a variety of shapes. We do not find any such teaching in these lines, which constitute part of a disclosure of various means (such as stitches or staples) for joining the edges. In particular, we find no disclosure of a "slit open composite;" while there is reference to making complex tubular articles from simple tubular articles, this would appear to describe the use of a flattened tube, as disclosed at column 11, lines 2 to 9, and shown in Fig. 6.

The secondary references disclose sleeves of shrinkable material with projection-and-recess means to join the free edges of the sleeve. We do not find any disclosure in these references which would suggest to one of ordinary skill in the art such a modification of Peacock as would meet all the limitations of claim 1. The rejection of claim 1 will therefore not be sustained. Likewise, the rejection of claims 2, 5 to 10 and 12 to 14, all of which are more limited in scope than claim 1, will not be sustained.

Rejections Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), we enter the following rejections:

1. Claims 1, 2 and 6 to 10 are rejected under 35 U.S.C. § 102(b) as anticipated by Ellis. The Ellis patent discloses a sleeve for a cable or pipe. Referring particularly to Figs. 6 and 7, sleeve 50 is made from a molded tube of heat recoverable material having a circular enlarged section and a rail 58 which is split longitudinally at 62, thus forming two outwardly extending tab portions. Since the sleeve is made from a preformed tube of the same material as that disclosed

by appellant, and the rail is cut or slit along its length (column 2, line 69; column 3, line 5), similar to the manner in which appellant's sleeve may be made (as disclosed at page 6, lines 4 to 7 of the specification), the tabs of Ellis would be inherently "biased toward each other" as recited in claim 1. As discussed previously, the term "biased" is broadly defined in the specification; it does not exclude the presence of some additional means for holding the tabs together, such as channel 60 of Ellis, but merely that the tabs have a "tendency ... to return to their position adjacent to each other" (page 2, lines 18 and 19).

As for claim 2, tabs 58 of Ellis have a portion, next to the enlarged section, which is "substantially planar."

The adhesive recited in claim 7 and crosslinked polymer recited in claim 8 are disclosed by Ellis at column 5, lines 35 to 37, and column 2, lines 50 to 53, respectively.

2. Claim 9 is rejected under 35 U.S.C. § 103 as unpatentable over Ellis in view of Cook. Ellis discloses at column 2, lines 47 to 50, that examples of heat recoverable materials usable for his invention may be found in the Cook patent. It therefore would have been obvious for one of ordinary skill in

Appeal No. 96-0043
Application 08/059,043

the art to make the Ellis sleeve out of a polyolefin material as disclosed by Cook at column 1, lines 17 to 29.

Conclusion

The examiner's decision to reject claims 1, 2, 5 to 10 and 12 to 14 is reversed. Claims 1, 2 and 6 to 9 are rejected pursuant to 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejections under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened

Appeal No. 96-0043
Application 08/059,043

statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

	IAN A. CALVERT)	
	Administrative Patent Judge))	
)	
)	
	MARC L. CAROFF)	BOARD OF
PATENT	Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
	CHUNG K. PAK)	
	Administrative Patent Judge))	

Appeal No. 96-0043
Application 08/059,043

Sheri M. Novack
Raychem Corporation
Mail Stop 120/6600
300 Constitution Drive
Menlo Park, CA 94025